

REMARKS

Abstract

The Examiner asserted that the Abstract exceeds the maximum allowed limit of 150 words and lacks clarity and conciseness. In response a new Abstract has been provided.

Claims 1, 2, and 5 were rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Takizawa et al.

In the statement of the rejection the Examiner made certain inaccurate findings as to the teachings of Takizawa et al. with respect to the claimed invention in support of the Examiner's determination that Takizawa et al. describe an optical wave guide module corresponding to that claimed. This rejection is traversed.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 66 USPQ2d 1801 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). Moreover, when imposing a rejection under 35 U.S.C. § 102 the Examiner is required to specifically identify where an applied reference identically discloses each feature of a claimed invention, particularly where such is not apparent as in the present case. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). That burden has not been discharged. Indeed, there are significant differences between the claimed module and the module disclosed by Takizawa et al. that scotch the factual determination that Takizawa

et al. disclose an optical waveguide module identically corresponding to that claimed.

Applicants submit that the imposed rejection suffers from an apparent misinterpretation of the module disclosed by Takizawa vis-à-vis the claimed module. Specifically, **independent claim 1** is directed to an optical module comprising, *inter alia*, an optical circuit having a groove formed therein. According to claim 1, the groove is "... formed at a predetermined inclination angle ... with respect to the vertical axis ... to cross a predetermined portion of said optical waveguide ...". Repeat, the groove is formed at a predetermined inclination angle with respect to the vertical axis and **crosses a predetermined portion of the optical waveguide**. In this respect Applicants would invite the Examiner's attention to Fig. 2 of the present application and the related discussion thereof in the written description of the specification, noting optical waveguide 2n and groove 3 crossing optical waveguide 2n at a predetermined angle.

On the other hand, as shown in Figs. 1 and 2 of Takizawa et al., the optical waveguide 22 is formed **in** the groove 11, noting also paragraph [0071] of Takizawa et al. Clearly, the groove 11 of Takizawa et al. does not cross the optical waveguide, but the optical waveguide is formed within the groove.

Further, Applicants separately argue the patentability of **claim 5**, although claim 5 clearly distinguishes over Takizawa et al. by virtue of its dependence upon independent claim 1. Claim 5 **further** requires "... an optical path changing means for changing the light path of said reflected light to a light path effecting incidence onto said light incident face of said photodetector at a predetermined angle with respect thereto." Thus, the optical path changing means is provided **in addition** to the reflection filter as apparent from the explicit terminology in

claim 5 "... further comprising an optical path changing means ...". No such structure is disclosed or suggested by Takizawa et al.

The above argued structural differences between the claimed module and the module disclosed by Takizawa et al. undermine the factual determination that Takizawa et al. disclose an optical waveguide module identically corresponding to that claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claims 1, 2 and 5 under 35 U.S.C. § 102 for lack of novelty as evidenced by Takizawa et al. is not factually viable and, hence, solicit withdrawal thereof.

Claims 3, 4 and 6 through 9 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Takizawa et al. in view of Kimura.

This rejection is traversed.

Claims 3, 4 and 6 through 9 depend from independent claim 1. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 102 for lack of novelty as evidenced by Takizawa et al. The secondary reference to Kimura does not cure the previously argued deficiencies of Takizawa et al. Accordingly, even if the applied references are combined as suggested by the Examiner, and Applicants do not agree that the requisite fact-based motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Further, Applicants separately argue the patentability of the dependent claims. Specifically, Applicants strenuously separately argue the patentability of **claim 4** which, by its own terms, further requires a "... mounting member ... disposed with said photodetector mounting face being obliquely inclined at an angle ... with respect to the top surface of said optical circuit ...". Neither Takizawa et al. nor Kimura disclose any such feature. Indeed, as shown in Fig. 4 of Kimura, contrary to the Examiner's assertion, the photodetector 40 is obliquely inclined just in the top view configuration. However, claim 4 specifies that the photodetector mounting face is "... obliquely inclined at an angle ... with respect to the top surface of said optical circuit ...". Accordingly, claim 4 is free of the applied prior art in its own right.

Applicants also separately argue the patentability of **claim 8**. Claim 8, by its own terms, expressly states that the "light incident face of said photodetector is obliquely inclined at an angle ... with respect to the top surface of said optical circuit ...". No such structure is disclosed by either Takizawa et al. or Kimura. Indeed, advertent to Fig. 4 of Kimura, it should be apparent that photodetector 40 is obliquely inclined just in the top view configuration, as previously pointed out. On the other hand, as shown in Fig. 12, and expressly stated in claim 8, the "... light incidence face of said photodetector is obliquely inclined at an angle ... with respect to the top surface of said optical circuit." No such structure is disclosed or suggested by the applied prior art, taken singly or in combination.

Based upon the foregoing it should be apparent that a *prima facie* basis to deny patentability to the claimed invention has not been established. Applicants, therefore, submit that the imposed rejection of claims 3, 4 and 6 through 9 under 35 U.S.C. § 103 for obviousness

predicated upon Takizawa et al. in view of Kimura is not factually or legally viable and, hence, solicit withdrawal thereof.

Claim 10 was rejected under 35 U.S.C. § 103 for obviousness predicated upon Takizawa et al. in view of Shanley.

Claim 11 was rejected under 35 U.S.C. § 103 for obviousness predicated upon Takizawa et al. in view of Yamamoto et al.

Each of the above rejections of claims 10 and 11 under 35 U.S.C. § 103 is traversed. Specifically, each of claims 10 and 11 depend from independent claim 1. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 102 for lack of novelty as evidenced by Takizawa et al. Neither Shanley nor Yamamoto et al. cure the previously argued deficiencies of Takizawa et al. Accordingly, even if the applied references are combined as suggested by the Examiner, and again Applicants do not agree that the requisite fact-based motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp., supra.*

Applicants, therefore, submit that the imposed rejection of claim 10 under 35 U.S.C. § 103 for obviousness predicated upon Takizawa et al. in view of Shanley, and the imposed rejection of claim 11 under 35 U.S.C. § 103 for obviousness predicated upon Takizawa et al. in view of Yamamoto et al., are not factually or legally viable and, hence, solicit withdrawal thereof.

Based upon the foregoing it should be apparent that the imposed rejections have been overcome, and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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